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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,784	08/05/2003	Masaaki Fusegi	482782007000	2733

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EXAMINER

LORENCE, RICHARD M

ART UNIT PAPER NUMBER

3681

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,784

Applicant(s)

FUSEGI ET AL. 

Examiner

Richard M. Lorence

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/6/03
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

This is the first Office action on the merits of Application No. 10/635,784 filed on August 5, 2003. Claims 1-16 are currently pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The disclosure is objected to because of the following informalities:

The description at page 10, line 26 to page 11, line 7 describe the clutch ring 51 and the mating gear 55 as forming "a pair of clutches", whereas the two elements actually define two clutch elements of the single dog clutch 13.

In instances too numerous to mention specifically the left and right directions are confused in the description. For example at page 11, lines 4-5 the gear 53 is said to be formed in a left end portion of the ring 51 whereas in Figure 1 of the drawings gear 53 is shown to be formed on the right end of the gear. Similarly, at lines 15-20 on page 11 the clutch is said to be engaged when the ring 51 is moved to the left as shown in the lower half of Figure 1. However in Figure 1 the clutch is shown engaged in the upper half of Figure 1 after the ring 51 has moved to the right, and disengaged in the lower half of the figure after the ring 51 is moved to the left. Also note the description at

lines 2-7 on page 15 where in line 4 "right" apparently should read - - left - -. It is suggested that applicant carefully check the specification to ensure that it agrees with what is actually depicted in the drawings.

In line 14 on page 23 the reference to "Fig. 16" is obviously in error.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not entirely clear what structure corresponds to the "retaining device" set forth in each of claims 1 and 15. Claim 3 appears to define the retaining device as the guide 253 described at page 25, line 8. However claim 4 appears to indicate that the retaining device is the stopper, i.e. the plate portion 91 on the first (fixed) plate, while claim 11 defines the retaining device as the folded portion 103 described at page 13, lines 19-21.

Claim 2 is believed to be incorrect. It is assumed that the first, second and third plates defined in claim 1 correspond to the elements 15, 19 and 17, respectively, since the plate 15 is fixed and the third plate 17 is engaged by the drive unit 27, 153. As such

claim 2 should state that the third plate (17) comprises the gear portion (107). Further, in claim 2 it is believed that "power transmission device" should be changed to - - drive unit - -.

Line 3 of claim 15 is believed to be incorrect in stating that the device includes a pair of clutches. In the device shown and described there is a single clutch 13 which includes a pair of engageable clutch elements 53, 55.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 as best understood are provisionally rejected under 35 U.S.C.

102(e) as being anticipated by copending Application No. 10/396,607 (published as US 2003/0184171 A1) which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application. Note particularly Figure 15.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 as best understood are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-26, 34 and 35 of copending Application No. 10/396,607. Although the conflicting claims are not identical, they are not patentably distinct from each other because each are directed to the actuator 1 shown in Figure 1 of the present application

which is apparently identical to the actuator 901 shown in Figure 15 of the co-pending '607 application. The first, second and third plates of claims 1 and 15 correspond to the support plate, movable plate and cam plate recited in claim 18 of the '607 application. The drive unit corresponds to the gear set and electric motor in claim 18 of the '607 application. The cam mechanism is also recited in claim 18 of the '607 application. The retaining device is believed to correspond to retainer of claim 23 of the '607 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Prior Art Citation

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Japanese patent document H05-54574 cited by applicant has been considered. Note the attached form PTO-1449. The examiner further cites Hagiwara et al. '486, Botterill '214, Botterill '640, Knapke '939 and Kurihara '740 (JP) which each disclose electric motor driven cam mechanisms for controlling clutch engagement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard M. Lorence whose telephone number is (703) 308-3062. The examiner can normally be reached on Mondays through Fridays from 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703) 308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard M. Lorence
Primary Examiner
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Lorence/rml